

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Skoro

Mailed: August 13, 2010

Opposition No. 91169226
Cancellation No. 92049146

Arcadia Group Brands Ltd

v.

Studio Moderna SA

Before Walsh, Cataldo and Bergsman,
Administrative Trademark Judges.

By the Board:

We assume the parties are familiar with the prosecution history of these proceedings and we will not review it except as necessary for this order.

By Board order of March 17, 2010, defendant's motion to dismiss was granted as to paragraphs 11-13¹ and 18² of the first amended complaint. By the same order, opposer/petitioner (hereinafter "plaintiff") was allowed

¹ Otherwise identified as "Ground 1", the Board dismissed these allegations finding that the Board had previously granted summary judgment in defendant's favor on April 26, 2007 on Ground 1, and as such, these allegations were unavailable under the law of the case. (March 17, 2010 Order, p.4).

² Otherwise identified as "Ground 4", the Board dismissed this allegation that defendant's recitation of services was overly broad, indefinite or can support a broad range of goods, holding that it was an ex parte examination issue and not proper for an inter partes proceeding. Further, that to the extent plaintiff seeks a Section 18 restriction, it had insufficiently pleaded abandonment.

time to amend its combined notice of opposition/petition to cancel (hereinafter "complaint") to "replead Ground 4 only to assert a Section 18 restriction, which includes a claim of abandonment in conjunction with its allegations of [defendant's] use on only five goods in connection with the Class 35 services, if appropriate." (Order p.8). Plaintiff was further instructed that if it chose not to amend Ground 4 to assert a Section 18 restriction, "it should nonetheless, file a 'clean copy' of the amended consolidated [complaint] in accordance with our ruling on the motion to dismiss to delete the unavailable grounds." (Order p.8).

On April 5, 2010, plaintiff timely filed a motion to amend its pleadings together with a second amended complaint. On April 23, 2010, defendant filed a motion to dismiss the second amended complaint. These motions are fully briefed.

In its motion to file a second amended complaint, plaintiff has failed to comply with the Board's order. It has repleaded dismissed paragraphs 11-13 and 18, contending it has done so to preserve any rights it may have on appeal before a Federal Circuit Court. Further, plaintiff has added new paragraphs 19 and 20³ which again challenge the scope of defendant's use of its mark and its recitation of services in its registration, seeking to amend the described

³ Previous paragraphs 19 and 20 have been renumbered 21 and 22.

services. Plaintiff has not alleged abandonment by defendant as to the goods it seeks to have "deleted" from defendant's registration as required. In fact, those goods do not appear in defendant's registration. Rather, plaintiff suggests two amended recitations of services.⁴ In response, defendant asserts in its motion to dismiss this second amended complaint that plaintiff has not clearly stated the restriction sought pursuant to Section 18 with precision to assert that such restriction will avoid a likelihood of confusion.

In order to restrict a registration under Section 18 of the Lanham Act, a petitioner must prove "(i) the entry of a proposed restriction to the goods and services in its opponent's application or registration will avoid a finding of likelihood of confusion and (ii) the opponent is not using its mark on those goods and services that will be effectively excluded from the . . . registration if the proposed restriction is entered." *Eurostar Inc. v. Euro-Star Reitmoden GmbH & Co. KG*, 34 USPQ2d 1266, 1270 (TTAB 1995).

⁴ Rather, plaintiff suggests an order amending defendant's registration from "On-line retail services in the field of general consumer merchandise" to: (1) On-line retail store services featuring dicing kitchenware, kitchen pans, kitchen knife, hand cleaning solution, and back remedy" or (2) "on-line retail store services featuring consumer household products of others, and excluding clothing, footwear, headgear, and accessories". (Second Amended complaint para. 20).

It is undisputed that defendant's use of its mark for retail services is not limited in the registration as plaintiff seeks to assert in its complaint, but rather that defendant's retail services are offered for a multitude of consumer goods. Thus, the restriction sought by plaintiff in its pleading fails to accurately identify the goods on which defendant is using its mark in connection with its retail store services. Further, plaintiff has not, and cannot, assert abandonment of items not set forth in the registration, thereby rendering plaintiff's restriction, or narrowing of defendant's recitation of services as set forth in plaintiff's pleading, unavailable as a matter of law and the proposed restriction unwarranted under Section 18.

Further, through its new proposed paragraphs 19 and 20, plaintiff again challenges defendant's "description of services [as] overly broad and indefinite." (para. 19). This is an attempt to re-assert the grounds which were dismissed by the Board, finding that the sufficiency of the recitation of services was "an ex parte examination issue which is not a proper ground for an inter partes proceeding. *See Century 21 Real Estate Corp. v. Century Life of America*, 10 USPQ2d 1024, 2035 (TTAB 1989)." (Order p.7).

In light of the foregoing, plaintiff's motion for leave to file a second amended complaint is hereby DENIED.

Plaintiff's first amended complaint, filed April 30, 2009,⁵ is now the operative document. Further, because plaintiff has failed to comply with the Board's Order⁶ in properly alleging sufficient grounds under Section 18 and submitting a clean copy of the complaint, the Board hereby strikes paragraphs 11, 12, 13 and 18 from the first amended complaint. In that plaintiff's motion to file a second amended complaint has been denied, defendant's motion to dismiss the complaint is hereby rendered moot.

Given the age and procedural history of this proceeding, dates herein are reset, however, both parties are advised that there will be no further extensions of time or suspensions granted, consented or not, absent a clear showing of extraordinary circumstances. Further, the parties must seek prior leave of the Board before filing any further motions and the parties are advised that any unwarranted delays in moving these cases forward may result in the Board sua sponte sanctioning the party responsible therefor. While these consolidated cases are now proceeding under the rules that went into effect in 2009, the dates as

⁵ Board docket entry No. 32.

⁶ The Board grows weary of plaintiff's inability to move these proceedings forward. The original opposition was filed on February 17, 2006. Since its inception, the parties have engaged in motions to dismiss, motions for summary judgment and numerous suspensions and extensions, only to arrive at this point, some four years later, without an answer to the first amended/consolidated complaint.

reset reflect an accelerated discovery period. The parties have engaged in, and the Board has mediated, several discovery motions prior to consolidation. Proceedings were suspended to allow for depositions on written questions, which plaintiff failed to take; and then it failed to directly respond to the Board's status inquiry. See Board order dated June 4, 2009, p.2.⁷ Further, the last Board order which reset dates stated that the parties needed to exchange initial disclosures in the cancellation proceeding before matters in that proceeding would be resumed. Given the history of these proceedings, it is assumed that both parties have enough information about each other's case to continue with discovery, and have information sufficient to satisfy the initial disclosures requirement. Accordingly, proceedings are resumed, and dates are reset as indicated below:

Time to Answer 1st Amended Complaint

9/6/2010

DISCOVERY IS OPEN	
Expert Disclosures Due	January 6, 2011
Discovery Closes	February 5, 2011
Plaintiff's Pretrial Disclosures	March 22, 2011
Plaintiff's 30-day Trial Period Ends	May 6, 2011
Defendant's Pretrial Disclosures	May 21, 2011
Defendant's 30-day Trial Period Ends	July 5, 2011
Plaintiff's Rebuttal Disclosures	July 20, 2011
Plaintiff's 15-day Rebuttal Period Ends	August 19, 2011

⁷ Board Docket Entry No. 40.

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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